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PAGES (Including Cover Sheet): <u>5</u>		
CONTENTS:	Appellant's Reply Brief (3 pages) Certificate of fax transmission (1 page)	
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Appellant's Reply Brief (3 pages)

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NO. 3403 P. 3

MAR 16 2005

Docket No.: YOR920000109US1
(20140-00247-US)
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:
Maria Ronay

Application No.: 09/577,347

Group Art Unit: 1765

Filed: May 24, 2000

Examiner: SONG, Matthew J.

For: SELECTIVE POLISHING WITH SLURRIES
CONTAINING POLYELECTROLYTES

APPELLANT'S REPLY BRIEF

Attention: Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in reply to the Examiner's Answer of January 25, 2005.

The examiner on the last line at page 10 argues that there is no support for excess polyelectrolyte explicitly or implicitly. This is in error since the present specification in the paragraph bridging pages 4 and 5 explicitly discloses that the quantity of polyelectrolytes in the abrasive composition is in excess of the amount which absorbs on the surface of the abrasive particles and therefore is present to some extent in composition as free or unabsorbed polyelectrolytes. It is believed that the portion of the polyelectrolyte in the supernatant portion of the slurry controls the polishing rate selectively. The claims at least implicitly include this feature by reciting that this polyelectrolyte is present in an amount sufficient to increase the recited polishing rate ratio. This is in contrast to the relative amounts disclosed in Ronay whereby the amount of polyelectrolyte is such that a fraction of the abrasive particles remain

uncoated (see column 2, lines 19, 20, 24 and 25; column 3, line 65—column 4, line 1; column 5, lines 16-19). The mere fact that the numeral ranges of amounts might overlap does not mean that the results will be the same, since whether or not excess polyelectrolyte is present not only depends upon an absolute numerical amount but also upon the selection of the polyelectrolyte and of the abrasive particles and the extent to which the polyelectrolyte becomes sorbed on the particles.

The examiner improperly relies upon inherency to justify the rejections of the claims in stating "increased polishing ratios would have naturally flowed"

Inherency requires that the recited results or structure must necessarily be obtained not merely that it might be achieved. See *Transclean Corp. v. Bridgewood Services Inc.* 62 USPQ2d 1917 (Fed. Cir. 2002), *Electra Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 32 USPQ2d 1017 (Fed. Cir. 1994); *In re Oelrich*, 212 USPQ 323 (CCPA 1981) and *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999).

The law is well settled that claiming of a more specific combination within a broader group of possibilities avoids a lack of novelty rejection. The test for anticipation is whether the claims read on the prior art disclosure, not on what the references broadly teach.

For example, see *Akzo N.V. v. U.S. International Trade Commissioner* 1 USPQ2d 1241 (Fed. Cir. 1986). In *Akzo*, the court found that no anticipation exists when one would have had to "randomly pick and choose among a number of different polyamides, a plurality of solvents and a range of inherent viscosities" to reach the claimed invention.

Also see *In re Kollman et al.* 201 USPQ 193 (CCPA-1979) wherein the court held that the prior art generic disclosure contains "no suggestion of the required FENAC/diphenyl ether ratio".

In Rem-Cru Titanium v. Watson 112 USPQ 88 (D.D.C-1956), the prior art showed alloys having broad ranges which included the claimed ranges. However, the prior art did not explicitly disclose the more limited claimed ranges or alloys having the characteristics of the claimed alloy. Accordingly, the court held the claims to be allowable. For a similar factual pattern and same holding, please see *Becket v. Coe* (CA, Dc 1938) 38 USPQ2d and *Tarak v. Watson* (DC-DC 1954) 103 USPQ 78.

In fact, the specific combinations suggested in Ronay could not result in the increased polishing ratios according to this invention. For example, for copper polishing, Ronay refers to using carboxyl-containing polyelectrolytes (anionic polyelectrolytes) (see column 7, lines 5-10); whereas, the present invention employs cationic polyelectrolyte for selectively polishing metals.

On the other hand, contrary to the present invention, for oxide polishing, Ronay discloses, specifically, cationic polyelectrolytes (see column 6, lines 32-38); whereas, for selective polishing of silicon dioxide compared to silicon nitride, an anionic polyelectrolyte is used.

Moreover, the present invention not only involves a selection of certain types of polishing compositions from the universe of possible polishing compositions, but also relates to very select surfaces being treated from the plethora of surfaces found in microelectronic structures.

Conclusion

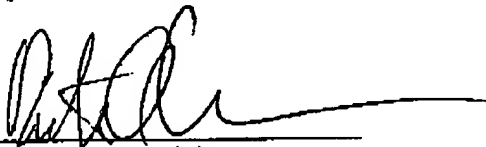
In view of the above, it is abundantly clear that the Primary Examiner erred in finally rejecting claims 13-36. Therefore, it is respectfully requested that the Board of reverse the Examiner and allow claims 13-36.

In the event the Examiner deems necessary any further cooperation to further the prosecution of this application, Appellant urges the Examiner to contact the undersigned.

The Commissioner is authorized to charge any required fees to Deposit Account No. 50-0510.

Dated: 3-15-05

Respectfully submitted,

By 

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